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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:
Sidle et al.

Serial No.: 10/643,644

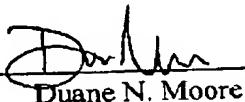
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Examiner: Saeed, Usmaan

Atty. Docket No.: ARC920030030US1

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Duane N. Moore

For: INCREMENTAL AST MAINTENANCE USING WORK AREAS

PETITION REGARDING 1.132 DECLARATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Petition is regarding the 1.132 Declaration filed by Applicants on June 27, 2006. The Examiner is requested to consider the following:

10/643,644

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I. MPEP 716.10 – Attribution

Section 716.10 of the MPEP provides that:

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship **does not raise a presumption of inventorship** with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide “a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor” of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author, patentee, or applicant of the published application of a first reference does not enable an applicant to step into the shoes of that author, patentee, or applicant of the published application in regard to its date of publication so as to defeat a later second reference. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

(emphasis added). The 1.132 Declaration filed by Applicants on June 27, 2006 (also referred to herein as the "1.132 Declaration") is proper under MPEP 716.10 because the Declaration: (1) "attribute[s] ... a reference or part of a reference to the applicant", (2) provides "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor' of the subject matter disclosed in the article and claimed in the application)", (3) provides "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article", and (4) there is no "evidence to the contrary" in regards to the "statement by the applicants regarding their inventorship in view of an article".

More specifically, the 1.132 Declaration "attribute[s] ... a reference or part of a reference to the applicant". The 1.132 Declaration provides that:

“Incremental Maintenance for Non-Distributive Aggregate Functions” discusses aspects of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644, filed on August 19, 2003 ... Richard Sidle, Roberta Cochrane and Hamid Pirahesh are the *only* joint inventors of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644. Further, because Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are also co-authors of “Incremental Maintenance for Non-Distributive Aggregate Functions”, “Incremental Maintenance for Non-Distributive Aggregate Functions” describes Applicants’ own work and should therefore be removed as a reference against claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644.

(pp. 2-3, emphasis in original). Applicants note that MPEP 716.10 only requires that Applicants “attribute ... a reference or *part of* a reference to the applicant” (emphasis added). Therefore, it is not required that the entire Palpanas paper be attributed to the co-inventors of the present application.

Additionally, the 1.132 Declaration provides “a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor’ of the subject matter disclosed in the article and claimed in the application). As noted above, the 1.132 Declaration provides that “Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are also co-authors of ‘Incremental Maintenance for Non-Distributive Aggregate Functions’” (p. 3). Moreover, the 1.132 Declaration provides that “Richard Sidle, Roberta Cochrane and Hamid Pirahesh are the *only* joint inventors of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644” (p. 3, emphasis in original). Therefore, because such statements were declared and signed by the joint inventors, “[applicant] is the ... inventor’ of the subject

matter disclosed in the article and claimed in the application" is a "reasonable conclusion".

Furthermore, the 1.132 Declaration provides "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article". As noted above, the 1.132 Declaration provides that "Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are also co-authors of 'Incremental Maintenance for Non-Distributive Aggregate Functions'" (p. 3). The 1.132 Declaration also provides that:

Although Themistoklis Palpanas is a co-author on "Incremental Maintenance for Non-Distributive Aggregate Functions" (August 2002), he is not an inventor of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644.

The portions of "Incremental Maintenance for Non-Distributive Aggregate Functions" that Themistoklis Palpanas contributed to are not defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644.

(pp. 2-3).

In addition, Applicants submit that there is no "evidence to the contrary" in regards to the "statement by the applicants regarding their inventorship in view of an article".

II. MPEP 2132.01 – Publications as 35 U.S.C. 102(a) Prior Art

Section 2132.01 of the MPEP provides that:

Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982) (discussed below). Therefore, where the applicant is one of the co-authors of a

publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant. Such affidavits are called disclaiming affidavits. *Ex parte Hirschler*, 110 USPQ 384 (Bd. App. 1952). The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

(emphasis added). Therefore, pursuant to MPEP 2132.01, "the publication may be removed as a reference" because: (1) "the applicant is one of the co-authors of a publication cited against his or her application", (2) Applicants filed "affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant", and (3) Applicants submitted "a specific declaration by the applicant establishing that the article is describing applicant's own work".

More specifically, the Palpanas paper should be removed as a reference under MPEP 2132.01 because "the applicant is one of the co-authors of a publication cited against his or her application". As discussed above, the 1.132 Declaration also provides that:

Richard Sidle, Roberta Cochrane and Hamid Pirahesh are the *only* joint inventors of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644. Further, because Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are also co-authors of "Incremental Maintenance for Non-Distributive Aggregate Functions", "Incremental Maintenance for Non-Distributive Aggregate Functions" describes Applicants' own work and should therefore be removed as a reference against claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644.

(p. 3, emphasis in original).

Applicants also note that MPEP 2132.01 states that “where the applicant is *one of* the co-authors of a publication cited against his or her application, the publication may be removed as a reference” (emphasis added). As such, it is not required that *all* of the inventors of the present application are common with *all* of the co-authors of the Palpanas paper.

Additionally, the Palpanas paper should be removed as a reference under MPEP 2132.01 because Applicants filed “affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant”. As described above, the 1.132 Declaration states that the Palpanas paper discusses aspects of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of the present application; Richard Sidle, Roberta Cochrane and Hamid Pirahesh are the *only* joint inventors of the invention defined by claims 1-4, 8-11, 15-17, and 21-24; and, Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are also co-authors of “Incremental Maintenance for Non-Distributive Aggregate Functions”. Moreover, Applicants submit that the 1.132 Declaration, including the portions of the 1.132 Declaration cited herewithin, is signed by Themistoklis Palpanas. Therefore, all of the co-authors of the Palpanas paper have signed the 1.132 Declaration. In view of the foregoing, Applicants also submit that the Palpanas paper should be removed as a reference under MPEP 2132.01 because they have submitted “a specific declaration by the applicant establishing that the article is describing applicant’s own work”.

Section 2132.01 of the MPEP also provides that:

However, if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, applicant’s

affidavit will not be enough to establish that applicant is the sole inventor and the rejection will stand. *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Int. 1982)

It is Applicants' position that there is no evidence that Themistoklis Palpanas has refused to disclaim inventorship and believes himself or herself to be an inventor. To the contrary, as discussed above, the 1.132 Declaration stating that Palpanas is not an inventor of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of the present invention is signed by Themistoklis Palpanas.

II. Formal Matters and Conclusion

Accordingly, Applicants submit that the 1.132 Declaration is proper under MPEP 716.10 because the Declaration: (1) "attribute[s] ... a reference or part of a reference to the applicant", (2) provides "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor' of the subject matter disclosed in the article and claimed in the application)", (3) provides "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article", and (4) there is no "evidence to the contrary" in regards to the "statement by the applicants regarding their inventorship in view of an article".

Furthermore, pursuant to MPEP 2132.01, "the publication may be removed as a reference" because: (1) "the applicant is one of the co-authors of a publication cited against his or her application", (2) Applicants filed "affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were

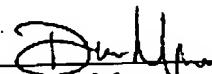
obtained from, applicant", and (3) Applicants submitted "a specific declaration by the applicant establishing that the article is describing applicant's own work".

Therefore, Applicants submit that claims 1-4, 8-11, 15-17, and 21-24, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: 1/03/07


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